

## REMARKS

Claims 1-32 are pending. Claims 1 and 17 are amended. No new matter is added. The Examiner rejected claims 1-32 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner further rejected claims 1-32 under 35 U.S.C. 102(b) as being anticipated by Microsoft Outlook 2000 ("Outlook"). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and remarks herein.

### **I. The 112 Rejections**

The Examiner rejected claims 1-32 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner further stated that "it is unclear how the electronic signature appearance is previewed in the bounding region of the document to be signed prior to signing the document" [Office Action, p. 2].

The applicant respectfully submits the Examiner has misunderstood what is meant by an electronic signature and electronically signing a document and has provided an amendment to independent claims 1 and 17 to clarify the language used in the claims. The remarks below specifically address claim 1, however, they apply equally to the other independent claim 17.

Claim 1 recites a method for signing an electronic document. In particular, the claim provides for establishing an electronic signature appearance for an electronic signature. In reading the claim, the difference between the appearance and the actual digital signature (termed "electronic signature" in the claim) must be kept in mind. Claim 1 has been amended to include that an electronic signature "comprises code derived from a signed electronic document and a private key" (see application, p. 1, lines 26-28 for support). By contrast, the electronic signature appearance includes "a visual manifestation of a signer's signature". With those definitions in mind, it should be clear that the electronic signature appearance, *i.e.*, the visual manifestation, can be previewed before the document is electronically signed, that is, before the electronic signature including the code derived from the signed electronic document and a private key is generated. This is an advantage of the method recited in claim 1, because a person electronically signing a document can preview the electronic signature *appearance* in the bounding region

before the document is electronically signed and if not satisfied with the electronic signature appearance, the person can edit the electronic signature appearance. Otherwise, without a preview feature as recited, the person would not have an opportunity to view the electronic signature appearance within the bounding region until the electronic document was already electronically signed, and if dissatisfied would have to re-sign another copy of the electronic document and discard or destroy the first signed electronic document.

The applicant trusts the clarification added into claim 1 and the discussion above provides clarity of this issue to the Examiner. However, if the Examiner remains unclear as to how the electronic signature appearance is previewed prior to signing the document, the applicant urges the Examiner to contact the applicant's representative, Brenda Leeds Binder at Fish & Richardson PC at 403-287-7244, to discuss the matter further.

## **II. The 102 Rejections**

The Examiner rejected claims 1-32 under 35 U.S.C. 102(b) as being anticipated by Outlook. The Examiner provided screenshots in Figures 1-5 from Outlook illustrating Outlook's "signature" feature, wherein a user can create a "signature" that is displayed within an email message prepared by the user in Outlook. Once created, the signature can be stored and reused, and can be automatically applied by Outlook to outgoing email messages generated by the user in Outlook.

The applicant respectfully submits the Examiner has misunderstood the important difference between an electronic signature and an electronic signature appearance. The signature feature shown in Figures 1-5 provided by the Examiner illustrate a signature *appearance* feature provided by Outlook. That is, the Outlook signature includes text and/or graphical images and provide an appearance of a signature. However, using the signature feature shown in Figures 1-5, the Outlook email message is not "electronically signed" nor is an "electronic signature" created, as those terms are known in the art and used and defined within the specification in some detail. As discussed above in relation to the 112 rejections, the difference between an electronic signature appearance and an electronic signature must be kept in mind, as these terms are fundamental to understanding the method recited in claim 1. The Outlook signature feature

shown in Figures 1-5 simply does not provide for an electronic signature, that is, code is not derived from an electronically signed document and a private key, when the Outlook signature is applied to an email message created in Outlook; there is no electronic signing of a document.

Accordingly, the applicant respectfully submits that at least the third and fourth elements of claims 1 and 17 are not described in Figures 1-5 of Outlook provided by the Examiner, because there is no electronic signing of a document, no preview of an electronic signature appearance in a bounding region, and no ability to then edit the electronic signature appearance after previewing but before electronically signing the document. Claims 1 and 17 are therefore not anticipated by the Outlook signature feature shown in Figs. 1-5 provided by the Examiner. Claims 2-16 and 18-32 depend from claims 1 and 17 respectively and are therefore allowable for at least the same reasons.

### **III. Conclusion**

For the foregoing reasons, the applicant submits that all claims are allowable. By responding in the foregoing remarks only to particular positions taken by the Examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

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Respectfully submitted,

Date: January 29, 2007 \_\_\_\_\_

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